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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,197	06/21/2001	Shinichi Tsuboi	Mo5000ND/NIT-259-ND	9181

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,197

Applicant(s)

TSUBOI ET AL.

Examiner

Sabiha Naim Qazi

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-- *Th MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 7,9,10,14 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 7, 9, 10, 14, and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Acknowledgement is made of the response and request for reconsideration in paper no. 9, dated 2/26/03. Amendments are entered. Claims 7, 9, 10, 14, and 19-21 are pending and stand rejected. No claim is allowed.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Arguments were fully considered but were found persuasive in part therefore, 102 and 103 rejections over Heuer et al. and 103 rejection Van Dyck et al. (EP 0148526) are withdrawn, other rejections are maintained for the same reasons as set forth in our previous office action.

1. Shiokawa et al. (US Patent 4,742,060)

Applicant argues that Shiokawa reference does not teach the presently amended claimed invention. Furthermore, argue that the range of concentration as presently claimed is not taught. Examiner disagree, because the ranges as presently claimed are taught, see lines 10-15 in column 54, where active compounds concentration for use can be 0.0000001 to 100% by weight of the active compound. Shiokawa reference clearly teaches the imidocalprid (compound 11 in column 58), which is an old insecticide, applied to same locus (wood) of claims. See column 12, lines 50-51 and 54, lines 18-20; the same compound is disclosed, see column 58, lines 30-35; the reference also teaches that same insects (disclosed on p-ages 6 and 7 of present specification) may be combated; see lines 60-67, col. 53. It also teaches

that that the other active compounds such as fungicides may be combined with imidazolidine insecticides.

2. Worthing et al. (Pesticide Manual, 9th edition)

Arguments that prior art does not teach specifically tebuconazole are not persuasive, because the reference teaches that a fungicide may be used in combination with the said imidazolidine compound. Worthing reference teaches that the fungicides such as tebuconazole are well known. This reference is used to show that fungicide tebuconazole is a well-known fungicide. Since fungicide tebuconazole is a known fungicide therefore, in view of teachings of Shiokawa and Worthing references one skilled in the art would be motivated to combine the imidazolidine compound of formula (as compound 11) and a fungicide tebuconazole.

It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In *re* Kerkhoven, 205 USPQ 1069. There is nothing inventive in a composition of old ingredients of known properties with each ingredient functioning individually as expected. In *re* Sussman. 58 USPQ 262.

In absence of any unexpected results presently claimed invention would have been obvious to one skilled in the art at the time of invention.

In the light of the forgoing discussion, the Examiner's ultimate legal

conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Claims 7, 9, 10, 14, and 19-21 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,972,971 for the same reasons as set forth in our previous office action.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of US '971 is drawn to a method and composition for preserving wood or timber products by using the combination of imidacloprid (compound listed as b in claim 1) and an azole compound.

Since the term "comprising" is cited in claims, which is inclusive and fails to exclude unrecited steps. The use of the term comprising to introduce claimed structure means that the ingredients covered by these claims may involve more elements than those positively recited. *Ex parte Gottzein et al.*, 168 USPQ 176 (PTO Bd. App. 1969. Comprising leaves the claim open for inclusion of unspecified ingredients even in major amounts. *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948). Therefore even if the third ingredient is not mentioned in the claims, claims are considered obvious because of the term "comprising".

Claim 3 further give a list, which includes tebuconazole (compound listed as d). US '971 claims the synergistic compositions. See in claim 1, compound b)

which is imidacloprid and in claim 3, compound d) which is tebuconazole. Same combination of compounds is claimed in present invention for preserving woods or timber products derived from wood (see claim 5).

Instant claims after amendments are narrower and selection of the claims of US '971.

It would have been obvious to one skilled in the art by reading the disclosure of US '971 to prepare a composition by combining imidacloprid and tebuconazole for preservation of wood or wood products because the reference teaches the same use. Present invention has the same assignee.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Naim Qazi whose telephone number is 703-305-3910. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



SABIHA QAZI, PH.D
PRIMARY EXAMINER